

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

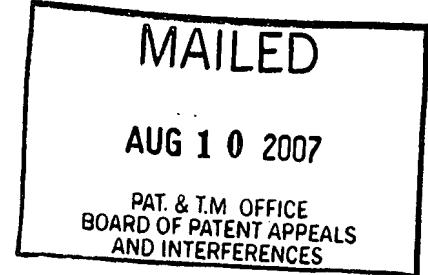
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Ex parte ROBERT B. HOPE

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Application 10/033,518

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on July 31, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the Examiner. The matters requiring attention prior to docketing are identified below:

APPEAL BRIEF

On August 25, 2006, Appellant filed an Appeal Brief. A review of the file reveals that the "Summary of Claimed Subject Matter" does not map each of the independent claims to the specification, as set forth in 37 CFR § 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Proper correction of the Appeal Brief is required.

When the Office holds the brief to be defective solely due to appellant's failure to provided a summary of the claimed subject matter as required by 37 CFR § 41.37(c)(1)(v), an entire new brief need not, and should not be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR § 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

#### EXAMINER'S ANSWER

On November 14, 2005, an Examiner's Answer was entered into the record. In the Evidence Relied Upon section, page no. 3, paragraph 8, the examiner has stated that "No evidence is relied upon by the examiner in the rejection of the claims under appeal." A review of the file reveals that references to Keys (U.S. Pat. No. 5,221,564), Iwasa (JP Pat. No. 408012815A),

and Vinay (U.S. Pat. No. 5,416,961) were applied to the statement of rejections in the Grounds of Rejection, paragraph (9) of the examiner's answer. Before further review, the examiner must mail a PTOL-90 that will include in the amended Evidence Relied Upon section, the list of references mentioned in the statement of rejections. See the Manual of Patent Examining Procedure, (MPEP) § 1207.02. Appropriate correction is required.

Accordingly, it is **ORDERED** that the application is returned to the Examiner to:

- 1) to hold the Appeal Brief filed on August 25, 2005, defective;
- 2) notify Appellant to file a paper providing a Summary of the Claimed Subject Matter as required by 37 CFR § 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR § 41.37 (c)(1)(v);

- 4) issue and mail a PTOL-90 having the missing references listed under the Evidence Relied Upon section, paragraph (8); and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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PJN:pgc

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